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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,423	07/19/2001	Craig Novak	394-137	7272

7590 07/30/2002

Gerard F. Dunne  
156 Fifth Avenue Suite 1223  
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EXAMINER

STERLING, AMY JO

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/909,423

Applicant(s)

NOVAK ET AL.

Examiner

Amy J. Sterling

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This is the **Final Office Action** for application number 09/909,423 Decorative Balloon Holder, filed on 7/9/01. Claims 1-16 are pending.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 8, 9, 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the printed publication titled the Fun Place, dated March 25, 1999 found on the internet at: <http://www.thefunplace.com/crafts/bagswrap.html> and in view of United States Patent No. 5441348 to Valentino.

The Fun Place publication discloses the applicant's inventive concept, a balloon holder having a decorative bag, a core is tucked on the inside of the bag, having sufficient weight to hold at least one buoyant balloon in place and positioned within the decorative bag, and decorative material covering the core in a position to conceal the core from casual view. Applicant also admits in his Reply, dated 6/27/02, that this structure is old in the art. (Page 1, lines 8-10).

Applicant argues that by securing the decorative material to the core and the core to the bag, that the structure above can be mass produced by automatic techniques, and can also be shipped, stored or displayed in a retail environment.

How the balloon holder is made, stored or displayed is not given as a positive limitation in the claims, nor is it even mentioned in the claims as an intended use of the balloon holder, so these purported uses of the item have been given no weight. That means the only issue in question is whether using tape to secure the decorative paper to the core and using tape to secure the core to the bag, is obvious.

"The rationale supporting an obvious rejection may be based on common knowledge in the art or well-known prior art. The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art. It is justified that the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that official notice can be taken, it is sufficient to state." In re Ahlert, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). (The board took official notice that it is common practice to postheat a weld after the welding operation is completed).

It is well known to the public domain, in fact the examiner takes Official Notice, that in any art, to use a liner, such as the tape, cited by the applicant in the specification, (page 10, items 34, 36), to secure items to their desired locations. This securing by tape of decorative elements, has been used in the art of decorative items, since tape was invented, in order to hold them to their desired locations and is an obvious and unpatentable by common knowledge.

The Fun Place publication does not specifically disclose where the decorative material could be formed from a length of decorative sheet material having its upper portion cut in to a series of strips adapted to extend outwardly from the decorative bag and its lower portion covering the peripheries of the core.

This particular limitation is shown in Valentino (See the last sentence in the abstract), stating that the "upper portion of each length of paper is cut longitudinally to enable the length to be...individually separated so that they may be able to form a decorative surface for an item placed within the bag". Valentino uses the structure in order to keep all of the decorative strands of one piece, so that strands do not fall out of the bag, during use. Therefore, it would be obvious from the teachings of Valentino to use this type of decorative material in the Fun Place reference, to keep the strands from falling out of the bag, during use.

Claims 4, 6, 10, 12, 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the printed publication titled the Fun Place, dated March 25, 1999 found on the internet at: <http://www.thefunplace.com/crafts/bagswrap.html> and in view of United States Patent No. 5441348 to Valentino and further in view of United States Patent No. 5044773 to Harms.

The only positive limitation cited in claims 4, 6, 10, 12, 15 is that the decorative bag has handles extending from an upper portion thereof. The functional language "to serve as an attachment for a string of one or more balloons" is only a suggested use and though the intended function of the device must not be used in conjunction with a reference, that in use would destroy the essence of the reference, the actual or same

function does not need to be specifically taught or disclosed, in order for the rejection to be valid. See MPEP 2114.

Therefore, the original rejection cited in the first Office Action regarding claims 4, 6, 10, 12, 15 stand as originally rejected, since securing a balloon to the handles in Harms, would not destroy the essence of the invention described in Harms.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the printed publication titled The Party Balloon, dated 2/2/01 found on the internet at: <http://www.thepartyballoon.com/products.html> in view of United States Patent No. 5441348 to Valentino.

The claims 1-4, 6, 8-10, 12, 14, 15 stand rejected under 103(a) for the same reasons as cited above.

Claims 5, 7, 11, 13, 16 stand rejected because The Party Balloon publication shows that the handles of the bag are secured together.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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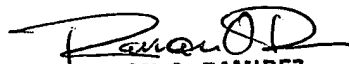
shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Amy J. Sterling at telephone number 703-308-3271. The examiner can normally be reached (M-F 8 a.m.-5:00 p.m.). If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax machine number for the Technology center is 703-305-3597 or 703-305-3598 (formal amendments) or 703-308-3519 (informal amendments/communications).

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist at 703-308-2168.



AJS  
Amy J. Sterling  
7/26/02



RAMON O. RAMIREZ  
PRIMARY EXAMINER  
ART UNIT ~~355~~ 3632